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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,428	08/30/2000	Brian Berson	1697P	2572

7590 10/18/2005	EXAMINER
Sawyer Law Group LLP	HUYNH, CONG LAC T
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Palo Alto, CA 94303	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/651,428	BERSON ET AL.
	Examiner	Art Unit	
	Cong-Lac Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 September 2005</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/26/05</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE filed 9/26/05 to the application

filed on 8/30/00.

2.   Claims 1-20 are pending in the case. Claims 1, 9, and 15 are independent

claims.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

5.   Claims 1-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over

Nielsen (US Pat No. 6,278,465 B1, 8/21/01, filed 6/23/97).

Regarding independent claim 1, Nielsen discloses:

- forming a database of font specifications (col 5, line 53 to col 6, line 27 and figure 5B, #524, #528, figure 5C, #542, #548: the Font Size Preference Database storing Font Sizes which are font specifications shows that such a font database is formed)

- accessing the database when opening documents to ensure usage of proper fonts (**figure 4 and col 5, lines 14-28**: *querying the Size Preference Database* when the *user access a URL* inherently shows accessing the Size Preference Database for querying, and opening documents when a URL is accessed)

- accessing the database when saving documents to ensure usage of proper fonts (**figure 5C, #542-550** and **col 5, line 53 to col 6, line 2**: if the user chooses "Yes" to the question "Do you want *the page displayed with the current font size from now on*", then the *URL and the preferred size are added to the Font Size Preference Database as a new record* if no record exists for this URL or *as a change to the existing record if one does exists*; adding the URL and the preferred size *as new record to the Font Database* or adding the URL and the preferred size as a change to the existing record if one does exist to the Font Database implies *accessing the Font Database to check the existence of the current font size in the database* and to *determine* that the URL and the preferred size is *a new record or merely a change*; adding the URL for the page along with the preferred font size to the Font Database *so that the page is displayed with*

the current font size "from now on" implies saving the page with the preferred

size to use from now on)

- the font specification includes at least one attribute (col 5, line 53 to col 6, line 27

and figure 5B, #524, #528, figure 5C, #542, #548: the font size is one attribute of

the font specification)

Nielsen does not disclose that the font specifications including at least two attributes of

a font. However, it would have been obvious to one of ordinary skill in the art at the

time of the invention was made to have incorporated the font style as a second attribute

to the font specification with one attribute in Nielsen since it was well known in Word

that a font specification basically includes the font style. The combination of such a font

specification with at least two attributes to Nielsen would provide more choices to users

in presenting various characteristics of a document.

Regarding claim 2, which is dependent on claim 1, Nielsen discloses accessing the

database when storing further comprising obtaining a font list for a document being

saved, and determining whether font specifications for each font in the font list exist in

the database (figure 5C, #548 Ask user if new font size should *be recorded or not in*

Preference Database where the database includes a font list for documents; figures 3A,

3C).

Regarding claim 3, which is dependent on claim 2, Nielsen discloses that when the font

specifications do exist, the method further comprises retrieving the font specifications

for each font from the database (figure 4, #410 URL found in size preference DB?, #430

Display file using the font stored in database: the fact that the system checks to see if

the URL found in size preference database and if yes, displays file using the font stored

in the database shows that the font specification of said URL in conjunction with the

URL is retrieved for displaying file using said font stored in the database; col 5, lines 14-

28).

Regarding claim 4, which is dependent on claim 3, Nielsen discloses that when the font

specifications do not exist, the method further comprises creating the font specifications

for each font (figure 5C, #548 and col 7, lines 45-59: the fact that if the URL does not

currently exist in the font size preference database, the user is asked if *the new font

size* should be recorded in the Font Size Preference Database shows a creating of the

font specification for a new font for a file document).

Regarding claim 5, which is dependent on claim 4, Nielsen discloses writing the font

specifications into the document, and saving the document (figure 5C, #542-#554: if the

URL is not in the font preference database, then *the new font is recorded* for the

document in the preferred font size database; this shows that the preferred font size,

which is the font specifications for the document referred by the URL, is written to the

document and saved in the database with the URL).

Regarding claim 6, which is dependent on claim 1, Nielsen discloses accessing the

database when opening documents further comprises retrieving font specifications from

a document being opened (figure 4; col 5, lines 14-28: " .. if the URL was found in the

Size Preference Database then the requested document is displayed using the

preferred font size retrieved from the database ..."; displaying the requested document

implies that the document is accessed).

Regarding claim 7, which is dependent on claim 6, Nielsen discloses searching the

database to locate each font specified by the font specifications in the document (col 5,

lines 14-28: the fact that based on the query, the URL was found in the Size Preference

Database shows searching the database is carried out to locate the font specification for

the document; "if the URL was not found in the Size Preference Database 410, *then a*

search (see FIG. 8) is made of the Sub-Site Database ...").

Regarding claim 8, which is dependent on claim 7, Nielsen discloses retrieving each

font located (col 5, lines 14-28: the font for the requested document is retrieved either in

the Size Preference Database or the Sub-Site Database).

Claims 9-14, 15-20 are for a system and a computer readable medium of method claims

1-8, and are rejected under the same rationale.

Response to Arguments

6.   Applicant's arguments filed 9/26/05 have been fully considered but they are not

persuasive.

Applicants argue that Nielson (used in 102(e) rejections) does not disclose accessing

the font database when saving documents to ensure usage of proper fonts since the

recording feature pointed in Nielsen is for recording fonts, not for recording the

document (Remarks, page 8).

Examiner respectfully disagrees.

The rejections of claims 1-20 in the previous action are under 35 U.S.C. 103 (a), not

102 (e) as mentioned by Applicants.

Nielson discloses accessing the font database when saving documents (col 5, line 53 to

col 6, line 2) since when answering "Yes" to the question "Do you want the page

displayed with the current font size from now on?", that means the page is saved with

the current font size at that time.   *In order to recognize whether said font is a new*

record or a change of the existing fonts, accessing the Font Database must be

performed to compare the current font with the fonts in the Font Database. Therefore, it

is clear that Nielson discloses accessing the font database when saving a document to

ensure usage of proper fonts.

Applicants argue that Nielsen expects users to modify the font pointsize, thereby

changing the way a document is imaged for comfortable viewing whereas the invention

is about never changing the way a document is imaged (Remarks, page 8).

Applicants' arguments are not persuasive since Nielsen does teach the claimed

limitations as mentioned in the rejections.

Applicants also argue that Nielsen does not disclose that the font specifications

including at least two attributes of a font as in claims 1, 9, and 15. See these claim

rejections for this argued feature.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Burns (US Pat No. 6,460,040 B1, 10/1/02, filed 1/6/00, priority 2/27/97).

Gauthier (US Pat No. 6,381,028 B1, 4/30/02, filed 4/26/99, priority 7/18/97).

Miller et al. (US Pat No. 6,512,522 B1, 1/28/03, filed 4/15/99).

Ying et al. (US Pat No. 6,853,980 B1, 2/8/05, filed 9/7/99).

Matsuo et al. (US Pat No. 6,775,729 B1, 8/10/04, filed 11/24/99).

Chan et al. (US Pat No. 6,073,147, 6/6/00, filed 6/10/97).

Flowers, Jr. et al. (US Pat No. 5,533,174, 7/2/96).

Cohen et al. (US Pat No. 6,510,426 B1, 1/21/03, filed 9/30/98).

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-

4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Cong-Lac Huynh
Examiner
Art Unit 2178
10/16/05